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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/131,744	08/10/1998	NORIBUMI KOITABASHI	884.2742	8265

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 02/24/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/131,744	Applicant(s) KOITABASHI ET AL.	
	Examiner Michael E. Grendzynski	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2, 8 and 10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4-7, 9 and 11-16 is/are allowed.
- 6) ☐ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Allowable Subject Matter

1. Species "a" (claims 1,4-7, 9 and 11-16) are allowable over the prior art of record.

Election/Restrictions

2. The restriction requirement made in paper No. 26 is withdrawn. Claims 11-16 are hereby rejoined and have been fully examined for patentability. The restriction requirement of Paper No. 26, however, remains. The examiner has chosen species "c" of Paper No. 24 (claim 3) in continuing the prosecution of the instant application. Claims 2, 8 and 10 remain withdrawn from further consideration.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-31 of copending Application No. 09/131,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to one of ordinary skill in the art to choose a first ink having a K_a of $1 \text{ ml/m}^2 \text{ msec}^{-1/2}$ and a second ink having a K_a of more than $1 \text{ ml/m}^2 \text{ msec}^{-1/2}$ (e.g., $5 \text{ ml/m}^2 \text{ msec}^{-1/2}$), thus meeting the limitations of the instant claims. The use of the open-ended transition term comprising, moreover, permits *any* colorant to exist in the processing liquid.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,379,000. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious for one of ordinary skill in the art to choose an ink having a K_a of less than $1 \text{ ml/m}^2 \text{ msec}^{-1/2}$ and a processing ink having a K_a of more than $1 \text{ ml/m}^2 \text{ msec}^{-1/2}$, as directed by the claim.

Specification

6. The use of the trademark Acetylenol® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koike (US 5608438). Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Koike (US 5608438). *See* Abstract. Applicants claim a recording method comprising the steps of (1) ejecting onto a recording material ink having a K_a value of not more than $1 \text{ ml/m}^2 \text{ msec}^{-1/2}$, (2) heating the ink and (3) applying a processing liquid thereto having a second K_a value of at least $1 \text{ ml/m}^2 \text{ msec}^{-1/2}$. Koike discloses an ink jet printing method comprising the steps of ejecting a first ink having a K_a value of $0.5 \text{ ml/m}^2 \text{ msec}^{-1/2}$ or less and jetting an second ink onto the first ink having a K_a of at least $1.0 \text{ ml/m}^2 \text{ msec}^{-1/2}$. *See* Abstract. The second ink is equivalent to applicants' processing liquid--the use of the open-ended transition term "comprising" does not exclude a colorant from existing in the processing liquid. Koike further discloses that a heating step is carried out continuously using a heater located on the recording device. *See* col. 9, ll 25-30.

9. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto. Yamamoto discloses an ink jet recording process comprising the steps of (1) ejecting a first ink having a first surface tension onto a recording substrate and (2) ejecting a color ink including a second ink which is rendered insoluble by the first ink when mixed. *See* Abstract. The first ink is equivalent to applicants' ink having a K_a of a first value. All inks inherently possess a K_a value with respect to an absorbing surface. In its examples, Yamamoto discloses an embodiment where the first ink does not comprise any Acetylenol®. *See* Example 3. Consequently, this would meet applicants' definition of a topping-type ink (i.e., an ink having a K_a value of $-1.0 \text{ ml/m}^2 \text{ msec}^{-1/2}$). The second ink, moreover, is equivalent to

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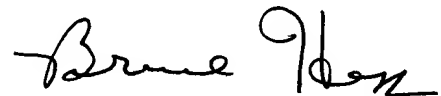
applicants' processing liquid. It comprises Acetylenol® in amounts equivalent to applicants' semi-penetrative ink (i.e., a liquid having a K_a value of 1.0-5.0 ml/m² msec^{-1/2}). See Table 1. The use of the open-ended transition term "comprising," moreover, does not exclude a colorant from existing in the processing liquid. The first ink was printed on the second ink. See p 13, l 35-39. The limitations of the claims, then, are met by the disclosure of the reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.



BRUCE H. HESS
PRIMARY EXAMINER

Michael E. Grendzynski
Assistant Examiner
February 14, 2003